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by Karen Orzechowski Signature: Karen Orzechowski

In re application of:	R. L. Bertram	:	Date: February 14, 2003
		:	
Serial No.:	09/089,098	:	IBM Corporation
		:	IP Law Dept. 9CCA/B002
Filed:	6/2/1998	:	P.O. Box 12195
		:	Res. Tri. Park, NC 27709
For:	Method and System for Reducing	:	
the Horizontal Space Required for		:	Group No.: 2178
Displaying a Column Containing Text Data		:	Examiner: Cong Lac T. Huynh
Assistant Commissioner for Patents			
Washington, DC 20231			RECEIVED

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**REPLY BRIEF TO EXAMINER'S ANSWER**

Sir:

This Reply Brief is filed pursuant to 37 CFR 1.193 in response to the Examiner's Answer mailed December 16, 2002. Appellant's complaint and portions of the Examiner's Answer with which appellant takes issue are identified in the headings hereinafter and where applicable the contention of the Examiner and the contention of appellant is set forth.

**A. EXAMINER'S ANSWER APPEARS DEFECTIVE**

In reviewing the Examiner's Answer it is noted that it is not signed by the Examiner. A copy of the unsigned signature page is submitted herewith as Exhibit A.

It is common practice and knowledge that in any judicial or quasi-judicial proceedings whether in a Court of Law or in an Administrative Agency the party submitting a document is obligated to sign. In fact, the obligation is imposed on attorneys or agents filing papers in the Patent Office. If the document is not signed it is believed that it would be deemed defective and inadmissible. The same practice and obligation should be binding on the Examiner.

Based upon the above, it is appellant's contention the Examiner's Answer is defective and inadmissible. Therefore, the decision regarding the rejected claims should be based on the record excluding the Examiner's Answer which is defective and should be stricken from the record. It is so requested.

Even though appellant believes the identified defect should make the Examiner's Answer inadmissible in the event the Board of Patent Appeals and Interferences ruled otherwise, appellant requests the remaining portion of this Reply Brief be considered relative to the Examiner's Answer.

**A1. EXAMINER ERRED IN RELYING ON FIGURE 4 APPELLANT'S  
SPECIFICATION) AS PRIOR ART**

It is appellant's contention the Examiner erred in relying on Figure 4 (appellant's specification) as prior art to invalidate appellant's claims. Reliance on Figure 4 as prior

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art is an error because Figure 4 is not a method, apparatus or computer program as claimed by appellant. Instead, Figure 4 is the table resulting from applying the "truncation" method set forth in Figure 2 (appellant's specification page 7, lines 10-23; page 8, lines 1-20, Figures 2, 3 and 4).

The method (Figure 2) used to generate the table in Figure 4 teaches a different invention from appellant's claims. In particular, the prior art method of Figure 3 uses "truncation" to shorten column headings whereas appellants claimed invention uses "abbreviation". The distinction between "truncation" and "abbreviation" is clearly set forth in appellant's specification argued in both appellant's Brief and appellant's Reply to the Examiner's Answer and are incorporated herein by reference.

In addition, appellants argue it seems to be improper for the result of a prior art method that is different from a claimed method rendering the claimed method obvious. Moreover, the problems (appellant's specification page 9, lines 8-20) associated with the prior art table in Figure 4 is corrected by the claimed invention. This indicates unobviousness and none of the claims are obvious in view of Figure 4.

**B. EXAMINER'S COMMENTS ON CLAIM 42**

**(PAGE 4 EXAMINER'S ANSWER)**

Regarding claim 42 and its rejection under 35 USC 103(a), the Examiner on page 4 of the Answer states: "Note: the rejection of claim 42 below (still based on figure 4) is modified for a better explanation of the claimed limitations". Because of the modification appellants are obliged to respond to the Examiner's contention stated to wit: "The prior art does not explicitly disclose defining a first character type as a space,

a second character type as a lower case letter. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the prior art to include defining the character types as a space, a lower vowel, and lower character since removing the characters of these types as disclosed above suggests defining these character types.”

Appellant contends there would be no need in the prior art to define, among other things, character types, as set forth in the claims 42 because the teachings of the prior art are inapposite to the character type definition recited in claim 42. The only prior art on which the Examiner relied is that which is disclosed in appellant’s specification. According to the prior art teachings a column is shortened by “truncation” in which a width (number of characters) is set by a user and the character string such as a heading to be shortened is compared with the width (number of characters). If the heading is wider the excess characters are cut off or lopped off (truncated). See appellant’s specification page 7, lines 10-23; page 8, lines 1-20 and related Figures 2, 3 and 4. The teachings of the prior art are so different from the invention claimed in claim 42 that one of ordinary skill would not have modified the prior art teachings to render claim 42 obvious. As a consequence claim 42 is patentable over the art of record.

### **C. REJECTION OF CLAIMS 43-48**

Claims 43-48 are rejected under 35 USC 103(a) with supporting arguments set forth on pages 5 and 6 of the Examiner’s Answer. The Examiner’s contention suggests that Figure 4 of appellant’s specification discloses the claimed invention and what is not disclosed is obvious in view of the same Figure 4.

Appellant contends Figure 4 does not teach step (b) which reads: "abbreviating a width of at least one entry" as recited in the claims.

It is often said the patentee is his/her own lexicographer. In no case is this saying more relevant than the present case. The appellant clearly distinguishes between "truncation" (prior art method of shortening a string of characters) and "abbreviating" (claimed method of shortening) a string of characters. The definition for both "truncation" and "abbreviation" are set forth in appellant's specification to which we now turn.

A reading of appellant's specification page 7, lines 10-23; page 8, lines 1-20 and related Figures 2, 3 and 4 suggest "truncation" (prior art method) requires a user to set a width (number of characters) for a column or other string of characters. If the column is wider than the width set by the user the excess characters are chopped off (truncated) (page 8, lines 9-15).

On the other hand "abbreviation" (appellant's claimed method) is set forth and described in appellant's specification pages 11-16 and Figures 5-8. In summary character types are defined and removed from the string of characters. As a consequence problems caused by truncation and set forth on page 7, lines 8-20 (appellant's specification) are eliminated. In addition, benefits set forth on page 16, lines 17-23 and page 17, lines 1-9 are provided by "abbreviation" rather than "truncation".

Because the specification defines and distinguishes both terminologies "abbreviating" as used in claim 43 should be given the interpretation set forth in the specification and distinguish from Figure 4 (prior art obtain by truncation). As a

consequence claim 43 and dependent claims 44-48 are not obvious in view of the prior art (Figure 4).

Claims 45-48 are patentable distinct in that each one claims specifies abbreviation steps not suggested in Figure 4 (prior art) which uses "truncation" to shorten a string of characters. The specific steps and benefits set forth above are evidence of unobviousness. Therefore, claims 45-58 are patentable over the art of record.

#### **D. CLAIM 49 (REJECTION MODIFIED)**

According to the Examiner, the rejection of claim 49 (still based on Figure 4) is modified for a better explanation of the claimed limitations. The Examiner seems to argue except for step (a) "determining a character type" the prior art (Figure 4) teaches claim 49. The Examiner concluded step (a) would have been obvious to one skilled in the art to specifically point out which character type in the string needs to be removed during the abbreviation.

Appellant contends the comparison between Figure 4 (prior art) and claim 49 is misplaced and in error because as argued above and incorporated herein by reference the technique used to derive Figure 4 is "truncation" rather than "abbreviation" recited in the claim. These methods are different and inapposite.

In addition, appellants argue "determining a character type would not have been obvious in that the "truncation" method of the prior art Figure 4 is not concerned with character types. Instead, the prior art "truncation" method cut off a portion of the character string leaving a portion that matches a predefined width. This teaching of the

prior art (Figure 4) is inapposite to the abbreviation method recited in claim 49. Therefore, claim 49 and dependent claim are not obvious in view of the prior art.

Claims 53-55 are patentable distinct in that character types are defined and removed if the character type is a specific type and the column heading is wider than a particular column width. One of the benefits is that the column width can be set to a size that distinguishes between the columns, thereby solving the problem inherent in the prior art Figure 4 and set forth on page 9, lines 10-14. A novel process step that solves problems in the prior art are evidence of nonobviousness.

Claim 56 is patentable distinct in that it calls for truncation and abbreviation. The truncation is activated if the character string or heading does not contain any character type and a predetermined width is desired.

#### **E. REJECTION OF CLAIMS 57-70**

According to the Examiner these claims are computer readable medium of method claims 43-56 and are rejected under the same rationale.

Appellants disagree with the Examiner's position and contend relying on the same rationale is improper because "the same rationale" includes Figure 4 as prior art. Figure 4, as argued above and incorporated herein by reference, is not a method or computer program and cannot be used to invalidate computer readable medium claims. Therefore, these claims are patentable over the art of record.

**F. REJECTION OF CLAIMS 71-73**

According to the Examiner these claims are for a system of method claims 49, 50, 53-56 and are rejected under the same rationale.

As argued under E (above), Figure 4 is not a method or system and cannot be used as prior art to invalidate system claims. Because Figure 4 is a result obtained from a method and system different from the system claimed in claims 71-72 it is appellant's contention that no art has been cited against claims 71-73. Therefore, these claims are patentable.

**G. REJECTION OF CLAIM 84**

Regarding claim 84 the Examiner states its rejection is still based upon Figure 4 but is modified for a better explanation of the claimed limitations.

The Examiner seems to argue claim 84, to wit: "sequentially removing predetermined individual characters . . ." is disclosed in Figure 4. The Examiner then seems to apply a three step procedure in which space, upper character and lower case characters are removed in Figure 4. The Examiner also widened the column heading from five bytes.

**EXAMINER ERRED IN CONSTRUING FIGURE 4**

As argued above and incorporated herein by reference Figure 4 is not a method.



It is a result outputted from the prior art method of "truncation". Therefore, it cannot be used to invalidate a claim that is based upon "abbreviation", a novel method from the prior art. Not only is claim 84 based upon a novel method of abbreviation but it requires the abbreviation to be done sequentially. By doing so sequentially the width of the resulting character string can be compared periodically and stop when the remaining width after each pass matches a desired width. This tends to reduce the time required to do the abbreviation. It is appellant's contention the novel method together with benefits are evidence of non-obviousness.

As to the Examiner's application of removal of characters to Figure 4, it is appellant's contention that the Examiner erred in removing the lower case characters. In this step the Examiner removed t, n, and e from "Bytesent" and concluded the result is "Bytes" as in Figure 4. This is an error because once a lower case character is defined all incidents of the character must be removed from the character string. Therefore, "Bytesent" would not reduce to "Bytes" as the Examiner seems to suggest.

#### **H. REJECTION OF CLAIMS 82 AND 83**

Regarding claims 82 and 83 the Examiner states they are still rejected based on Figure 4 but modified for better explanation of the claimed invention.

As argued above and incorporated herein by reference it is improper to use Figure 4 as prior art to invalidate appellant's claims since Figure 4 is not a method. It is only the result which is produced using the prior art truncation. It is also undesirable because it identifies multiple columns with the same name. This defect is cured by the claimed invention. Therefore, claims 82 and 83 are not obvious in view of Figure 4.

Moreover, the Examiner erred in applying, among other things, C2 of appellant's claim to "BytesSent". In this step the Examiner removed lower case characters e, n, and t. Apparently the Examiner only removed one "e" and one "t" to reach the result of "BytesS".

It is appellant's contention that once a character is defined all incidents of it must be removed from the string. Therefore, when "e" is removed from "BytesSent" two incidents of "e" should be removed and not one as was done by the Examiner. Similarly, two "t"s should be removed and not one as was done by the Examiner.

Even though the Examiner admits the prior art (Figure 4) does not teach "determining N character types . . . " as recited in the claim, the Examiner concludes it would be obvious because the prior art shows the removing of the characters of different types.

In response, appellant argues the prior art is not concerned with character types. The prior art teaches away from appellant's invention in that it uses "truncation" which requires lopping off the portion of the string of characters that is greater than a predefined width without regards to the contents of what is lopped off. Therefore, claim 82 is not obvious in view of Figure 4.

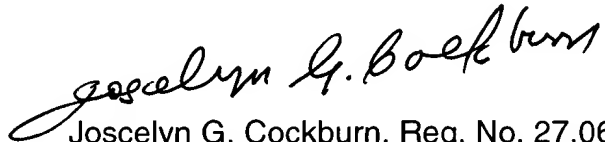
As to claim 83 the Examiner's analysis is in error because multiple incidents of a character is not eliminated when the character string is greater than a predefined width. Due to the faulty analysis the Examiner erroneously concluded claim 83 is obvious in view of Figure 4.

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Atty. Docket No.: **PATENT**  
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In view of the above we believe the claims on appeal present patentable subject matter and the Examiner should be reversed.

Respectfully Submitted,



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**Date:** FEBRUARY 14, 2003

**In re Application of:** R. BERTRAM

**Serial Number:** 09/089,098

**Filed:** JUNE 2, 1998

**For:** Method and System for Reducing the Horizontal Space  
Required for Displaying a Column Containing Text Data

**Art Unit:** 2178

**Examiner:** Cong Lac T. Huynh

X No additional fee is required.

The Commissioner is authorized to charge payment of any additional fees required under 37 CFR §1.16 and 37 CFR §1.17 or to credit any overpayment to designated Deposit Account 09-1990. A duplicate copy of this sheet is enclosed.

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**Date:** FEBRUARY 14, 2003

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